



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Jean-Louis GUERET

Application No.: 10/779,725

Examiner: R. RUNNING

Filed: February 18, 2004

Docket No.: 118556

For: A PACKAGING AND APPLICATOR DEVICE FOR A COSMETIC OR ANOTHER
CARE PRODUCT

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are directed to the points of argument in the Examiner's Answer dated June 25, 2008. In particular, the Reply Brief responds to the following arguments raised on pages 9-11 of the Examiner's Answer:

(1) because Stange is allegedly "capable of" being friction fit into a receptacle it meets the claim limitation "configured for fixing onto a receptacle;"

(2) the separation in Stange allegedly may be at an angle of 10-60° to support the two application positions language;

(3) there is allegedly no clear definition of "application position;"

(4) the two "application modes" allegedly do not require the user to actively apply the device;

(5) one allegedly would have been able to use simple substitution of the handle in Vasas for the handle in Stange to obtain a predictable result; and

(6) Shay's storage receptacle allegedly can receive Stange's device once dry and thus would not destroy the intended purpose of Stange.

Each of these arguments will be addressed in more detail below. However, Appellant's summarized response is as follows:

Regarding point (1), Appellant asserts that the "configured for" language is a positive recitation of structure that is not present in Stange. Moreover, mere "capability" of having a friction fit as alleged does not anticipate the present claims because Stange does not teach a receptacle at all and thus does not provide a specific shape and precise size to achieve a friction fit as alleged.

Regarding point (2), Appellant points out that any embodiment of Stange would have a singular angle and thus only a single application position and a different drying position.

Regarding point (3), Appellant argues that when read in light of the specification, it is clear that "application mode" and "application position" refer to positions in which a product is "applied" on a user, such as applying of mascara. Stange has only a single application position.

Regarding point (4), Appellant argues that the application modes do refer to application of product and are thus not any arbitrary position.

Regarding point (5), Appellant argues that Stange is not configured for fixing on a receptacle. Moreover, Vasas does not have a base portion, separate from the handle and rotatable relative to the handle, that contains a fixing structure.

Regarding point (6), it is possible that even if combined the combination would result in a fixing of the handle to the receptacle, not a base portion separate from the handle that is provided with specific fixing structure.

Appellant's detailed Response follows:

A. Claims 1, 3, 4, 6, 10-18, 20, 23, 25-27, 30, 34, 37-40 and 42 are Not Anticipated By Stange

Claims 1, 3, 4, 6, 10-18, 20, 23, 25-27, 30, 34, 37-40 and 42 are rejected as anticipated under 35 U.S.C. §102(b) by Stange (German Patent Publication No. DE29614364). This rejection is respectfully traversed.

With respect to independent claims 1, 34 and 42, the Patent Office continues to improperly ignore the recited "configured for fixing onto a receptacle" language, which is a positive recitation of structure that must be given patentable weight.

The Examiner's Answer alleges on page 9 that a "friction fit is considered to be fixed." Therefore, the Examiner's Answer reasons that "since Stange is capable of being friction fit onto a receptacle it meets the claim limitation." The Examiner's Answer goes on to state that it has been held that the recitation "capable of" performing a function is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138, 54 F.2d 135 (CCPA 1946). Appellant respectfully submits that these arguments are misplaced and not relevant to the rejected claims.

First, the claims do not recite "capable of," but instead as repeatedly argued recite "configured for," which is a positive recitation of structure necessary to achieve the resultant fixing (such as, for example, Applicant's Fig. 4 and ¶ [0012] that show a screw thread as a suitable corresponding structure by which the base portion is configured for fixing onto the receptacle, or dependent claim 9 which defines more specific structure, as does claim 31 which specifically recites fixing means, activating §112, paragraph 6). Thus, *In re Hutchinson* is not pertinent to the issue at hand and claims 1, 34 and 42 should be construed as positively reciting suitable structure that achieves such fixing.

Second, the rejection is based on 35 U.S.C. §102(b) anticipation. In order to establish a *prima facie* case of anticipation, the Patent Office must establish that each and every

element of a claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814, F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). Moreover, "to serve as an anticipation when the reference is silent about the asserted inherent characteristic...evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by a person of ordinary skill" (emphasis added). *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). This has not been established.

As mentioned above, the Examiner's Answer supposes that a "friction fit is considered to be fixed." Therefore, the Examiner's Answer reasons that "since Stange is capable of being friction fit onto a receptacle it meets the claim limitation." However, there is no specific teaching, explicit or implicit, of the handle being specifically sized and shaped to achieve a "friction fit" with an undisclosed and unnecessary receptacle. Instead, Stange's handle is "intended" to be merely placed on a table. Absent a teaching of a specific receptacle for storage, there is no inherent teaching that the Stange handle is "configured for fixing onto a receptacle" as alleged. Thus, there is only the alleged possibility that Stange's handle is "capable of" being so fixed (if it were specifically shaped and precisely sized to achieve such a friction fit, which it is not). Instead, it is only through impermissible hindsight consideration of Appellant's teachings that the Examiner's Answer forms the basis for alleging that the handle in Stange is "capable of" being friction fit. The allegation that Stange "could" be fixed to a receptacle is thus factually flawed for an anticipating reference because such a reference must teach each and every feature in order to be anticipatory. Stange fails to do so. Therefore, a *prima facie* case of anticipation has not been made.

Moreover, independent claims 1, 34 and 42 recite, *inter alia*, that "the base portion and the handle portion cooperate in such a manner as to enable a user to secure the handle portion in at least two predefined application positions relative to the base portion."

The Examiner's Answer alleges on page 10 that "Appellant has not clearly defined what an 'application position' is." From this, the Examiner's Answer further asserts that there is "nothing precluding the user from using the device in any of the positions as disclosed by Stange." In this regard, it is alleged that Stange teaches an angle of 10 to 60 degrees. Appellant disagrees.

When read in light of Appellant's specification, one would understand that the applicator applies substance (such as make-up or mascara) to a user's eyelashes, eyebrows, etc. at two different inclinations (paragraph [0041]) allowing, for example, applying of make-up or mascara to the left eye or right eye using the same hand movements (paragraph [0010]). See, for example, Applicant's Figs. 16-19, which show multiple application positions. Thus, the claims do not merely state that the applicator is positioned at two arbitrary positions or modes, but two "application positions" or "application modes" at which a product such as mascara is placed on the applicator and "applied" on a user. In construing a claim for obviousness (as well as anticipation), all of the limitations of the claims must be considered and given weight. MPEP §2143.03. *Ex parte* Grasselli, 23 USPQ 393 (Bd. App. 1983) *aff'd* mem. 738 F.2d 453 (Fed. Cir. 1984). Thus, "application" is a modifier of position and mode that defines a particular type of functionality that is achieved at such a position and during such a mode. In light of Appellant's specification, "application" is understood to mean a position where application of a product, such as mascara, takes place.

Stange, however, provides a brush that applies product such as shaving cream in a single disclosed vertical position. Because of the nature of the vertical position and water being on the brush, Stange provides a different angled position that is solely taught to be a

drying position. This allows the brush to dry without the water dripping on the handle. Thus, Stange fails to teach or suggest two application positions. As mentioned previously, patentable weight must be given to each and every claim limitation. *Ex parte Grasselli*.

Moreover, even though a range of 10-60 degrees is disclosed in Stange, with a preferred range of 45 degrees, the angle is a single value for any given embodiment. Thus, there will still only be a single application position and a different drying position.

Because a reference must teach each and every feature in order to be anticipatory and Stange fails to do so, a *prima facie* case of anticipation has not been made with respect to independent claims 1, 34, and 42. Moreover, the mere fact that references can be combined or modified from other uncited or disclosed teachings does not meet the anticipation standard, and does not even render the resultant combination obvious unless the prior art also suggests a rationale for the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) and *KSR International Co. v. Teleflex Inc.*, 550 U.S. _____, 82 USPQ 2d 1385, 1396 (2007). No such desirability or rationale is found in Stange because the sole purpose of the extra position is to allow for drying. Thus, the Examiner's position may only be gleaned from impermissible hindsight consideration of Applicant's specification.

With respect to method claim 37, the Office Action fails to make a *prima facie* case of anticipation because it fails to identify a teaching of the method step of modifying a direction of the base between two different application modes. Instead, as discussed above, Stange provides a brush that is mobile relative to the handle so as to enable drying of the brush (without soap or water remaining trapped within the bristles). Thus, Stange teaches only a single application mode (i.e., conventional use in the vertical position for application of shaving cream), and a different angled position for the sole purpose of drying (which does not apply product to the user and is thus not an "application" mode). This latter position is necessitated by the vertical positioning of the brush above the handle to achieve drying. This

latter position is not taught to be useful for applying shaving cream and thus does not suggest using a second application mode.

In determining differences between the prior art and the claims, it is not whether the differences themselves would have been obvious, but whether the claimed invention "as a whole" would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The teachings of Stange do not teach or provide a rationale for providing two different "application" modes as claimed during which product is applied to a user.

Because a reference must teach each and every feature in order to be anticipatory and Stange fails to do so, a *prima facie* case of anticipation has not been made with respect to independent claim 37 because the specific method steps are not disclosed.

Therefore, Appellant respectfully submits that independent claims 1, 34, 37 and 42 and claims dependent therefrom are patentable over Stange. Accordingly, withdrawal of the rejection over Stange is respectfully requested.

B. Claims 1, 3, 4, 7-18, 20, 23, 25-27, 30-32, 34-40 and 42 Would Not Have Been Obvious From Vasas in view of Stange

Claims 1, 3, 4, 7-18, 20, 23, 25-27, 30-32, 34-40 and 42 are rejected as having been obvious under 35 U.S.C. §103(a) over Vasas (U.S. Patent No. 6,237,609) in view of Stange. This rejection is respectfully traversed.

The Examiner's Answer on the bottom of page 10 alleges that "the prior art reference need not teach or suggest all the claim limitations" citing MPEP §2141(III). The Examiner's Answer goes on to rely on *KSR* and alleges that "one having ordinary skill in the art would have been able to use simple substitution of the handle of Vasas for the handle of Stange to obtain predictable results; for instance to allow for a more ergonomic handle." However, MPEP 2141 (III) and *KSR* still require a "rationale" for the alleged combination or

modification. The Final Rejection and Examiner's Answer only provide a conclusory result that if combined (for no identified reason or rationale) the predictable result would be a more ergonomic handle (another conclusory statement). Thus, there is still no rationale for the alleged combination as required under *KSR*.

As discussed above, Stange's base portion is not "configured for" fixing onto a receptacle and is instead a stand alone brush designed to be placed on a flat surface with the brush exposed for drying. Vasas' handle may be configured for fixing. However, Vasas does not have a base portion separate from the handle and rotatable relative to the handle, and thus fails to teach a fixing structure on a base portion separate from the handle.

Moreover, neither Stange nor Vasas is concerned with advantages achieved by having two application modes which allow, for example, the brush to apply mascara to the left or right eye with the same hand movement (Applicant's paragraph [0010]) or to change the angle of attack for a different application effect (Applicant's paragraph [0009]). Instead, a shaving brush as in Stange just needs to generally apply shaving cream over a face in a non-exact manner. Thus, with respect to independent method claim 37, Stange like Vasas fails to teach two application modes.

One of ordinary skill in the art also would not have had reason to combine Stange and Vasas for the alleged purpose of allowing the "user to use multiple angles of tilt while applying a product" as alleged because both references teach only a single application position and each teaches the same position (i.e., with the brush extending parallel with the handle axis).

Accordingly, independent claims 1, 34, 37 and 42 and claims dependent therefrom patentably distinguish over Vasas and Stange. Withdrawal of the rejection is respectfully requested.

**C. Claims 7-9, 31, 32, and 35 Would Not Have Been Obvious
 From Stange in View of Shay**

Claims 7-9, 31, 32, and 35 are rejected as having been obvious under 35 U.S.C.

§103(a) over Stange in view of Shay (U.S. Patent No. 397,028). This rejection is respectfully traversed.

The Office Action alleges that it would have been obvious to place the shaving brush of Stange on the Shay receptacle. However, Stange fails to teach or provide a reason for providing the recited structure or means for "fixing" recited in the dependent claims. Stange also fails to teach or provide a reason for providing a receptacle with the applicator of claim 1 as recited in claim 35.

Shay fails to overcome the deficiencies of Stange. If attachment was by fixing of the handle of Stange onto the Shay receptacle so as leave the brush exposed to allow drying as taught by Stange, the fixing would be provided on the handle, instead of by the base as claimed. Accordingly, there is no reason for the alleged combination or the combination does not necessarily result in the claimed combination of features.

Accordingly, claims 7-9, 31, 32, and 35 are allowable for their dependence on allowable base claim 1, as well as for the additional fixing or receptacle structural features recited in those claims. Withdrawal of the rejection is respectfully requested.

II. CONCLUSION

For all of the reasons discussed above, Appellants respectfully request this Honorable Board to reverse the rejections of claims 1, 3, 4, 6-32, 34-40, and 42.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. P. Berridge', written over a horizontal line.

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